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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,935	08/02/2001	Brigitte Bathe	211712US0X	5782
22850	7590	03/23/2005	EXAMINER HUTSON, RICHARD G	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT 1652	
DATE MAILED: 03/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,935

Applicant(s)

BATHE ET AL.

Examiner

Richard G. Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,36-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-58 is/are allowed.
- 6) ☒ Claim(s) 34,36,40-44,46-48,50-55,59-79 and 81 is/are rejected.
- 7) ☒ Claim(s) 37-39,45,49 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants cancellation of claims 9-33 and 35, the amendment of claims 34, 36-39, 46, 49, 50, 54, 56, and the addition of new claims 63-81 in the paper of 12/21/2004, is acknowledged. Claims 34, 36-81 are still at issue and are present for examination.

Applicants' arguments filed on 12/21/2004, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Objections

Claims 37-39, 45, 49, 54 and 80 are objected to because of the following informalities:

Claims 37-38, 45, 49 and 80 are dependent on rejected claim 34.

Claim 54 recites both "SEQ ID NO. 1" and SEQ ID No. 1". It is suggested that applicants maintain consistency throughout the application.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34, 36, 40-44, 46-48, 50-53, 55, 63-79 and 81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 34, 36, 40-44, 46-48, 50-53, 55, 63-79 and 81 are rejected under this statute because the recitation in claim 34, "...identical to a fragment of SEQ ID NO: 2 which has methylene tetrahydrofolate reductase activity" is not supported by the specification at the time of filing and is thus considered new matter. More specifically, claim 34 as now written is drawn to the genus of polynucleotides that encode a polypeptide having methylene tetrahydrofolate reductase activity, wherein said polypeptide is at least identical to a "fragment of SEQ ID NO: 2 which has methylene tetrahydrofolate reductase activity". That genus having 90% identity to a fragment of SEQ ID NO: 2 which has methylene tetrahydrofolate reductase activity is not supported by the specification and is thus considered new matter.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Claims 34, 36, 40-44, 46-48, 50-55, 59-79 and 81 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a polynucleotide which encodes a protein having the amino acid sequence of SEQ ID NO:

2, wherein said protein has methylene tetrahydrofolate reductase activity, does not reasonably provide enablement for any polynucleotide which encodes a polypeptide which is merely 90% identical to SEQ ID NO: 2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection was stated in the previous office action as it applied to previous claims 34, 35, 36, 39, 40-44, 46-48, and 50-58. In response to this rejection applicants have amended claims 34, 36, 39, 46, 50, 54, and 56, and added new claims 63-81 and traverse the rejection as it applies to the newly amended claims.

Applicants amendment of the claims has now resulted in applicants limiting the claimed genus to those polynucleotides which encode a polypeptide which has methylene tetrahydrofolate reductase activity. While such an amendment is constructive in limiting the claimed genus of polynucleotides to those which encode a polypeptide which has methylene tetrahydrofolate reductase activity and thus a function, the claims remain rejected under this statute because applicants have not provided sufficient guidance as to how to make the majority of those polynucleotides of the claimed genus encoding such polypeptides (i.e. that genus of polynucleotides encoding such polypeptides and having 90% identity to a fragment of SEQ ID NO:2).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is (571) 272-0930. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Richard G. Hutson', with a stylized flourish at the end.

Richard G Hutson, Ph.D.
Primary Examiner
Art Unit 1652

rg
3/8/2005